

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL REICHGOTT, ABHIJIT CHATTERJEE, and
CHARLES SCHELL

Appeal 2007-3718
Application 09/353,583
Technology Center 2600

Decided: April 28, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and CARLA
M. KRIVAK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
rejection of claims 1-46. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' claimed invention relates to the prevention of disruptions in the functioning of a set-top terminal due to the downloading of updated programming or data via a cable network. When a download of data or programming is offered to the set-top terminal over the cable network, the set-top terminal will accept the download only when predetermined criteria are met. (Specification 4-6).

Claim 1 is illustrative of the invention and reads as follows:

1. A set-top terminal for connecting a subscriber to a cable network, said terminal comprising:

a processor; and

a memory unit,

wherein the processor monitors an out-of-band control channel of the cable network for information indicating that a download of data or programming is available and indicating a specified in-band channel for receiving the download of data or programming offered to said set-top terminal over said cable network, wherein said processor only accepts said download on said specified in-band channel and records said download in said memory unit when one or more predetermined criteria are satisfied, and wherein said criteria when satisfied indicates that acceptance of said download will cause a minimum of interference with said subscriber's use of said set-top terminal.

The Examiner relies on the following prior art references to show unpatentability:

Chen ¹	US 4,636,942	Jan. 13, 1987
Diehl	US 5,373,557	Dec. 13, 1994
Bacon	US 5,440,632	Aug. 8, 1995
Banker	US 5,497,187	Mar. 5, 1996
McClellan	US 5,619,250	Apr. 8, 1997
Iggulden	US 5,987,210	Nov. 16, 1999
Kraml	US 6,141,683	Oct. 31, 2000

Claims 1-4, 6-17, 24-27, 30-35, and 41-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bacon in view of Banker.

Claims 5 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bacon in view of Banker and further in view of Diehl.

Claims 18, 19, 21-23, 29, 36, 37, 39, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bacon in view of Banker and further in view of McClellan.

Claims 20 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bacon in view of Banker and McClellan and further in view of Iggulden.

Claims 45 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bacon in view of Banker and further in view of Kraml.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only

¹ The Chen reference has been cited by the Examiner as evidentiary support for the rejection of claim 41 but is not, itself, part of the stated rejection.

those arguments actually made by Appellants have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

(i) Under 35 U.S.C. § 103(a), with respect to appealed claims 1-4, 6-17, 24-27, 30-35, and 41-44, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Bacon and Banker to render the claimed invention unpatentable?

(ii) Under 35 U.S.C. § 103(a), with respect to appealed claims 5, 18-23, 28, 29, 36-40, 45, and 46, would one of ordinary skill in the art at the time of the invention have found it obvious to modify the combination of Bacon and Banker by adding various combinations of the Diehl, McClellan, Iggulden, and Kraml references to render the claimed invention unpatentable?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears

the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, ““there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

I. The rejection based on Bacon in view of Banker Claims 1-4, 6-17, 24-27, 30-35, 41, and 42

With respect to the obviousness rejection of independent claims 1, 24, and 41, Appellants’ arguments in response assert a failure by the Examiner to establish a *prima facie* case of obviousness since, even if combined, all of the claimed limitations would not be taught or suggested by the applied Bacon and Banker prior art references. In particular, Appellants contend (App. Br. 6, 7, and 11; Reply Br. 2-4, 8, and 9) that, in contrast to the claimed invention, neither Bacon nor Banker, nor their combination, teach or suggest the monitoring of, or the receiving on, an out-of-band channel information indicating that a download of data or programming is available on a specified in-band channel.

After reviewing the disclosures of Bacon and Banker in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Briefs. With respect to Bacon, the Examiner initially calls attention (Ans. 5) to the disclosure at column 8, lines 17-50 which indicates that authorization and control data can be transmitted by any of the described out-of-band, in-band audio, or in-band video transmission schemes. While such a disclosure would seem to satisfy the claimed requirement that data is downloaded over an out-of-band channel, it is also apparent that the remainder of the claim limitations are not satisfied since there is no disclosure in Bacon that the downloaded information is to be received by a specified in-band channel.

The Examiner in further support of the stated position refers to the illustration in Bacon's Figures 3A-3D and the accompanying description beginning at column 9, line 25. In particular, the Examiner directs attention to the discussion of Bytes 16 and 17 in the Figure 3A illustration of the parameters transaction data in Bacon which are disclosed (Bacon, col. 9, ll. 66-68) as indicating the channel on which downloaded code transactions are to be received. We agree with Appellants (Reply Br. 3), however, that there is no indication given in Bacon that such receipt of downloaded code is on in-band channels or that the transaction data is in fact delivered over an out-of-band channel as claimed.

We further find ourselves in agreement with Appellants (App. Br. 7; Reply Br. 4) that the Banker reference does not overcome any of the previously discussed deficiencies of Bacon. Although Banker does disclose

(e.g., col. 8, l. 60 et seq.) that control data can be transmitted over an out-of-band channel, such a teaching adds nothing to the existing teachings of Bacon as previously discussed. As with Bacon, there is no disclosure in Banker that any control data that is transmitted over an out-of-band channel includes information as to a specified in-band channel for receiving available download information.

In view of the above discussion, we are of the opinion that the applied Bacon and Banker references, even if combined, do not support the obviousness rejection. We, therefore, do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1, 24, and 41, nor of claims 2-4, 6-17, 25-27, 30-35, and 42 dependent thereon.

Independent claim 43 and its dependent claim 44

We do not sustain the rejection of these claims as well. Independent claim 43 differs from previously discussed independent claims 1, 24, and 41 in that, while requiring monitoring of transmissions that indicate a download of information is available at a specified channel, there is no requirement that the monitored transmissions be over an out-of-band channel or that the specified download channel is an in-band channel. Claim 43, however, does include a "deadline" feature in which a download of information is required to be accepted by a subscriber by a specified point of time.

We agree with Appellants (App. Br. 7-8; Reply Br. 4-5) that this "deadline" feature is not disclosed in either Bacon or Banker. As pointed out by Appellants, the "timeout" feature discussed at column 16, lines 20-42 of Bacon referenced by the Examiner can not reasonably be considered to be

a “deadline” since downloads are permitted to be postponed indefinitely if the subscriber responds negatively to the convenience flag (Bacon, Figure 10, blocks A88 and A94).

*II. The rejection based on Bacon in view of Banker and Diehl
Dependent claims 5 and 28*

This rejection is not sustained. The Examiner has added the Diehl reference to the combination of Bacon and Banker to address the “time-of-day” features of dependent claims 5 and 28. We find nothing, however, in the disclosure of Diehl which overcomes the innate deficiencies of Bacon and Banker discussed *supra*.

*III. The rejection based on Bacon in view of Banker and McClellan
Claims 18, 19, and 21-23*

We do not find Appellants’ arguments to be persuasive and, accordingly, sustain the Examiner’s obviousness rejection of independent claim 18, as well as dependent claims 19 and 21-23 not separately argued by Appellants. At the outset, we note that, unlike previously discussed independent claims 1, 24, and 41 which require the monitoring of an “out-of-band” channel for information of downloading on a specified “in-band” channel, independent claim 18 has no recitation of “out-of-band” signaling. In addition, although the language of claim 18 requires that an offered download specify a channel for receiving the download, there is no requirement, unlike independent claims 1, 24, and 41, that such specified channel be an “in-band” channel. As such, the previously discussed portion

of Bacon (col. 9, ll. 66-68), referenced by the Examiner, satisfies this feature of the claim.

With respect to the McClellan reference, we do not necessarily disagree with Appellants' contention (App. Br. 9-10; Reply Br. 5-8) that McClellan discloses only that new downloaded programming will execute after downloading is completed. We find ourselves in agreement with the Examiner (Ans. 12 and 20-23), however, that this completion of downloading, or that the downloaded new modules are "fully functional" as described at column 7, lines 31-32 of McClellan, is a "predetermined criteria" which governs the execution of new downloaded programming as presently claimed.

We also make the observation that, to whatever extent the Examiner is relying on McClellan to provide a teaching of delaying execution of new downloaded programming until predetermined criteria are satisfied, this teaching is cumulative to what exists in Bacon. As described, for example, at column 16, lines 12-42 of Bacon, the system of Bacon will check to determine if a subscriber's "convenience" flag has been set and will thereafter wait for a positive response from the subscriber, i.e., a predetermined criteria, before executing new downloaded programming.²

In view of the above discussion, although we find no error in the Examiner's addition of McClellan to the combination of Bacon and Banker,

² It is apparent from the record before us that Appellants consider a subscriber's positive response as a "predetermined criteria," since this is the subject matter present in dependent claim 23.

it is our opinion that the Examiner's obviousness rejection of independent claim 18, as well as dependent claims 19 and 21-23 not separately argued by Appellants, is sustainable based solely on the combination of Bacon and Banker.³

Claims 29, 36, 37, 39, and 40

The rejection of independent claim 36, and its dependent claims 37, 39, and 40, as well as dependent claim 29 included in this rejected claim grouping by the Examiner, is not sustained. As with previously discussed independent claims 1, 24, and 41, and unlike independent claim 18, independent claim 36 recites limitations requiring the "out-of-band" receipt of information which indicates a specified "in-band" channel that will receive updated programming. While we disagree with Appellants' arguments with respect to McClellan's teachings of the use of predetermined criteria to govern execution of new programming as discussed *supra*, we find that McClellan has no disclosure which overcomes the innate deficiencies of Bacon and Banker in disclosing the specific "out-of-band" and "in-band" signaling features. The obviousness rejection of dependent claim 29 is also sustained based on the reversal of the Examiner's rejection of its independent base claim 24.

³ The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

IV. The rejection based on Bacon, Banker, McClellan, and Iggulden.

Dependent claim 20

We do sustain the Examiner's 35 U.S.C § 103(a) rejection of dependent claim 20 in which the Iggulden reference is added to the applied prior art to address the language of claim 20 in which the "predetermined criteria" for execution of new downloaded programming is specified to be the detection of a commercial break. We find no error, and there are no convincing arguments from Appellants to the contrary, in the Examiner's finding (Ans. 14 and 25-28) that the commercial break detection feature taught by Iggulden would serve as an obvious enhancement to the combined systems of Bacon and Banker, or Bacon, Banker, and McClellan. We further agree with the Examiner (Ans. 27) that Appellants' contention that Iggulden lacks any disclosure of "out-of-band" signaling is unpersuasive since, at the very least, there is no "out-of-band" signaling requirement present in dependent 20, nor in its base claim 18.

Dependent claim 38

We do not sustain this rejection. As with the McClellan reference previously discussed with respect to base independent claim 36, we find no disclosure in Iggulden which overcomes the deficiencies of Bacon and Banker in satisfying the particular claimed "out-of-band" and "in-band" limitations.

*V. The rejection based on Bacon in view of Banker and Kraml
Claims 45 and 46*

Appellants' arguments (Br. 14; Reply Br. 11) do not convince us of any error in the Examiner's 35 U.S.C § 103(a) rejection, in which Kraml is added to the combination of Bacon and Banker, of independent claim 45, nor of dependent claim 46 not separately argued by Appellants. Accordingly, we sustain the Examiner's obviousness rejection of these claims.

As pointed out by the Examiner (Ans. 15, 16, 29, and 30), Kraml (col. 5, ll. 22-27 and 45-57) discloses the execution of an older version of programming if a newer version becomes unusable. We fail to see, Appellants arguments to the contrary notwithstanding, why the commands discussed, for example, in the explanation of the Figure 4 flowchart beginning at column 5, line 39 of Kraml, would not be considered commands to switch programming versions as broadly set forth in independent claim 45.

CONCLUSION

In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejections of the appealed claims, we have not sustained the rejections of claims 1-17 and 24-44, but have sustained the rejection of claims 18-23, 45, and 46. Accordingly, the Examiner's decision rejecting appealed claims 1-46 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED-IN-PART

gvw

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